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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/582,336	05/25/2007	Yoichi Kakudo	47487-0001-00 (226811)	4907
55694 7590 04/15/2010 DRINKER BIDDLE & REATH (DC) 1500 K STREET, N.W. SUITE 1100 WASHINGTON, DC 20005-1209				
EXAMINER				
MOORE, WALTER A				
ART UNIT		PAPER NUMBER		
1783				
NOTIFICATION DATE		DELIVERY MODE		
04/15/2010		ELECTRONIC		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

DBRIPDocket@dbi.com

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### Office Action Summary

**Application No.**

10/582,336

**Applicant(s)**

KAKUDO ET AL.

**Examiner**

WALTER MOORE

**Art Unit**

1783

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 24 February 2010.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1,3-9,11,14 and 16-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_\_ is/are rejected.
- 7) ☒ Claim(s) 1,3-9,11,14 and 16-20 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB06)  
Paper No(s)/Mail Date 05252007
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

**RESPONSE TO AMENDMENT**

***Status of Claims***

1. Claims 1, 3-9, 11, 14, 16-20 are pending. Claims 2, 12-13, and 15 were canceled, claims 3-9, 11, 14, and 16-20 were amended in the response filed on 2/24/2010.
2. Claims 10 and 21-23 were canceled in the response filed on 7/28/2009.

***Information Disclosure Statement***

3. The IDS filed on 05/25/2007 has been considered. The signed and initialed IDS is attached to this Office Action.

***Withdrawn Rejections***

4. The 35 USC 112 rejections of claims 4-5, made of record in the office action mailed on 11/25/2009, have been withdrawn due to applicant's amendment filed on 2/24/2010.
5. The 35 USC 102 rejections of claims 2, 12, and 15 as anticipated by CarBomb as evidenced by Guinness; Jameson's Whiskey; Guinness Stout; Bailey's Irish Cream made of record in the office action mailed on 11/25/2009, have been withdrawn due to applicant's amendment filed on 2/24/2010.
6. The 35 USC 103 rejections of claims 2, 12-13, and 15, as obvious over Hoppy", in view of either Shinozaki or Global Gourmet, as evidenced by Japan – Taxes on Alcoholic Beverages, made of record in the office action mailed on 11/25/2009, have been withdrawn due to applicant's amendment filed on 2/24/2010.

**REJECTIONS**

7. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

***Claim Rejections - 35 USC § 102***

8. Claims 1, 3-6, 9, and 19-20 are rejected under 35 U.S.C. 102(b) as being anticipated by The Webtender, "CarBomb" (retrieved on 11/16/2009, published on 10 February 2003), as evidenced by the following: "Guinness" (retrieved on 11/17/2009, published on 16 April 2003); Drinkmixer for Jameson's Whiskey (retrieved on 11/17/2009, published on 19 October 2003); Drinkmixer for Guinness Stout (retrieved on 11/17/2009, published on 9 October 2003); and Drinkmixer for Bailey's Irish Cream (retrieved on 11/17/2009, published on 11 October 2003).

Regarding claims 1-2 and 9, The Webtender teaches a malt fermented beverage (Carbomb) comprising an alcohol containing material made of fermented barley (Guinness stout) and an alcohol containing distillate made from barley (Jameson's Whiskey).

Regarding the alcohol content, The Webtender teaches mixing 13 oz of component A (Guinness) with 1 oz of component B (Whiskey) resulting in a volume ratio of 13:1. The alcohol content of component B (Jameson's) is 40% (see Drinkmixer Jameson's) and alcohol content of component A (Guinness Stout) is 4.1% (see Drinkmixer Guinness stout) and. Therefore, a ratio of the alcohol content from the components is 9.75:1 (Whiskey:Beer = .40/.041 = 9.75:1).

Regarding claims 3-6, Guinness is beer made with malt, barley, hops, and water (see "Guinness", p. 1, Brewing Materials section).

Regarding claim 19, The Webtender teaches using Jameson's Whiskey, which has 40% alcohol (80 proof, Drinkmixer for Jameson's Whiskey).

Regarding claim 20, The Webtender teaches mixing 13oz of component A (Guinness), 1oz component B (Whiskey), and 1oz Irish cream (Baileys). This results in a alcohol percentage of about 7.4% (Calculation:  $C_aV_a + C_bV_b + C_{\text{Irish}}V_{\text{Irish}} = C_tV_t = 4.1\%(13\text{oz}) + 40\%(1\text{oz}) + 17\%(1\text{oz}) = 1.103$ ;  $1.103/15\text{oz} = 0.007353 = 7.353\%$ ).

***Claim Rejections - 35 USC § 103***

9. Claims 7 and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over The Webtender, "CarBomb", as evidenced by "Guinness" and Drinkmixer for Jameson's Whiskey (retrieved on 11/17/2009, published on 19 October 2003); Drinkmixer for Guinness Stout (retrieved on 11/17/2009, published on 9 October 2003); and Drinkmixer for Bailey's Irish Cream (retrieved on 11/17/2009, published on 11 October 2003), as applied to claims 1, 3-6, 9, and 19-20 above, and further in view of Tripp et al., USPN 5,618,572.

The Webtender is relied on as above.

The Webtender does not teach the malt proportion of component A.

Tripp is drawn to preparing beer and malt beverages (Abstract). Tripp teaches changing the malt proportion of beer changes the flavor profile of the final product (col. 8, ln. 67 to col. 9, ln. 1). Tripp suggests malt proportions from 26% (21/79 malt/dextrose, col. 8, ln. 63) to 127% (56:44 malt/dextrose, col. 9, ln. 1-2). Tripp also suggests using a beer comprising between 80-100% malt (col. 4, ln. 5). Tripp teaches the flavored malt beverages minimize the consumer sensation of fullness, meaning they are drinkable and refreshing (col. 9, ln. 30-31). Furthermore,

Tripp suggests the malt base can be used as a mixture “for all manner of liquors” (col. 10, ln. 18-21).

Therefore, the flavor profile of the final product is deemed to be a result effective variable with regard to the malt proportion. It would require routine experimentation to determine the optimum value of a result effective variable, such as malt proportion, in the absence of a showing of criticality in the claimed malt proportion. One of ordinary skill in the art at the time of invention would have been motivated to change the malt proportion, as taught by Tripp, to obtain a final product having acceptable drinkability and taste (col. 9, ln. 30-31). Furthermore, Tripp expressly suggests malt proportion ranges, which overlap the claimed ranges.

10. Claims 1, 3-6, 9, 11, 14, 16, 19, and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hoppy de Happy-to (“Hoppy de Happy Dokuhon”, Kabushiki Kaisha Asupekuto; 22 August, 2000) hereinafter “Hoppy”, in view of either Shinozaki et al., JP 60241883 (English Abstract) or Global Gourmet (retrieved on 11/21/2009, published on 10/04/2003), as evidenced by Japan – Taxes on Alcoholic Beverages.

Note the examiner attached a human translation of the Hoppy document. The citations have been changed to reference the human translation.

Regarding claims 1 and 9, Hoppy teaches malt fermented beverage comprising two components. Component A is an alcohol containing material made of barley (Hoppy, translation p. 4, last paragraph). Component B is an alcohol containing distillate (shochu, p. 2, last paragraph).

Regarding the alcohol ratio of claim 1 and claim 19: Hoppy teaches the shochu is 25 degree. The examiner notes the applicant's provided translation of the Japanese document translated text box number 1 on page 1 as 25 proof. However, the document actually states 25 degree. In Japanese tax law 25 degree alcohol equates to percent alcohol (Japan – Taxes on Alcoholic Beverages, p. 6, paragraph 2.3 and Shochu A table). The December 2009 human translation of Hoppy translates the term “degree” as alcohol content by volume (p. 2, last paragraph).

Hoppy teaches component A has an alcohol content of 0.8% (p. 4, second to last paragraph). Therefore, a ratio of the alcohol content of the components is 31.25 (Shochu:Hoppy =  $31.25 = .25/.008$ ). In the event that the translation of Hoppy (provided on 05/25/2007) is correct and the Hoppy has a proof of 25, which is 12.5% alcohol, a ratio of alcohol content is 15.625 (Shochu:Hoppy =  $31.25 = .125/.008$ ).

Regarding claims 1, 11, 14, and 16, Hoppy does not teach the alcohol containing distillate (shochu) is made from wheat.

Shinozaki teaches an otsu mugi shochu that has a having mellow and rich flavor. Shinozaki teaches the shochu is made from wheat. It would have been obvious to one of ordinary skill in the art at the time of invention to use a wheat shochu, as taught in Shinozaki, to obtain a malt beverage having otsu mugi shochu because the otsu mugi shochu has a mellow and rich flavor.

In the alternative, to Hoppy in view of Shinozaki, Hoppy teaches discloses the claimed material except for the materials used to make component B (shochu). Global Gourmet teaches shochu is made from various grains including wheat. It would have been obvious to one having

ordinary skill in the art at the time the invention was made to select shochu made from wheat, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. MPEP 2144.07.

Regarding claims 3-5, Hoppy teaches component A (Hoppy) comprises malt, starch (cornstarch), and hops (p. 6, first full paragraph). Hoppy does not expressly teach component A comprises water. However, Hoppy teaches the ingredients are boiled together (p. 6, first full paragraph) and brewed in the same way as beer (p. 4, last paragraph). Therefore, Hoppy at least implies component A comprises water. In the alternative, Examiner takes official notice that beer comprises water.

Regarding claim 6, Hoppy teaches component A (Hoppy) is beer (p. 2, first paragraph).

Regarding claim 20, Hoppy teaches the alcohol content of the malt beverage is between 3% and 8% (translation p. 2, last paragraph).

11. Claims 7, 8, 17, and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hoppy de Happy-to (“Hoppy de Happy Dokuhon”, Kabushiki Kaisha Asupekuto; 22 August, 2000) hereinafter “Hoppy”, in view of either Shinozaki et al., JP 60241883 (English Abstract) or Global Gourmet (retrieved on 11/21/2009, published on 10/04/2003), as evidenced by Japan – Taxes on Alcoholic Beverages, as applied to claims 1, 3-6, 9, 11, 14, 16, 19, and 20 above and further in view of Tripp et al., USPN 5,618,572.

Hoppy in view of either Shinozaki or Global Gourmet is relied on as above.



Hoppy in view of either Shinozaki or Global Gourmet does not teach the malt content of component A.

Regarding claims 7, 8, and 17-18, Tripp is drawn to preparing beer and malt beverages (Abstract). Tripp teaches changing the malt proportion of beer changes the flavor profile of the final product (col. 8, ln. 67 to col. 9, ln. 1). Tripp suggests malt proportions from 26% (21/79 malt/dextrose, col. 8, ln. 63) to 127% (56:44 malt/dextrose, col. 9, ln. 1-2). Tripp also suggests using a beer comprising between 80-100% malt (col. 4, ln. 5). Tripp teaches the flavored malt beverages minimize the consumer sensation of fullness, meaning they are drinkable and refreshing (col. 9, ln. 30-31). Furthermore, Tripp suggests the malt base can be used as a mixture “for all manner of liquors” (col. 10, ln. 18-21).

Therefore, the flavor profile of the final product is deemed to be a result effective variable with regard to the malt proportion. It would require routine experimentation to determine the optimum value of a result effective variable, such as malt proportion, in the absence of a showing of criticality in the claimed malt proportion. One of ordinary skill in the art at the time of invention would have been motivated to change the malt proportion, as taught by Tripp, to obtain a final product having acceptable drinkability and taste (col. 9, ln. 30-31). Furthermore, Tripp expressly suggests malt proportion ranges, which overlap the claimed ranges.

Regarding the wheat spirit of claim 18, as discussed above, both Shinozaki and Global Gourmet teach the shochu is made from wheat.

Regarding claim 17, the limitation “is otsu-rui shochu” (otsu-rui shochu means produced in a batch distiller) is a method limitation and does not determine the patentability of the product, unless the process produces unexpected results. The method of forming the product is not

germane to the issue of patentability of the product itself, unless Applicant presents evidence from which the Examiner could reasonably conclude that the claimed product differs in kind from those of the prior art. MPEP 2113.

***Response to Arguments***

12. Applicant's arguments filed 2/24/2010 have been fully considered but they are not persuasive.

Regarding the CarBomb reference, applicant argues the alcohol content is “from” each component, not “of” each component (p. 8, 1<sup>st</sup> paragraph). Examiner is not persuaded by this argument. Although the applicant’s interpretation is one possible interpretation, the claims do not necessarily limit the claims to the applicant's interpretation. The claim claims “an alcohol content from” component A and “an alcohol content from” component B. The Whiskey has “an alcohol content” of 40%. The Guinness has “an alcohol content” of 4.1%. The ratio of alcohol contents is 40%:4.1%. So, a ratio between an alcohol content (4.1%) from component A (Guinness) and an alcohol content (40%) from component B (Whiskey) is 40%/4.1%.

Applicant asserts that the claimed alcohol content “should be calculated” as  $CaVa : CbVb$  (Remarks, p. 8). However, the phrase “alcohol content” is not defined by the specification to mean concentration multiplied by volume. Therefore, the claim does not limit the meaning of alcohol content to the exemplary formulation in the specification.

Applicant argues the calculation of the CarBomb ratio is incorrect because the Office switched the numerator and denominator (Remarks, p. 8). However, claim 1 claims “a ratio” of

the components A and B is between 97.5:2.5 to about 90:10. The claim does not claim the ratio of A:B. Therefore, the ratio of B:A (Whiskey:Guinness) reads on the claimed limitation.

Regarding the Hoppy reference, applicant argues the calculation of the Hoppy ratio is incorrect because the Office switched the numerator and denominator (Remarks, p.10, last paragraph). However, claim 1 claims "a ratio" of the components A and B is between 97.5:2.5 to about 90:10. The claim does not claim the ratio of A:B. Therefore, the ratio of B:A (shochu:Hoppy) reads on the claimed limitation.

Applicant argues that Hoppy does not disclose a crisp taste or robust feel (Remarks, p. 11, last paragraph). Examiner is not persuaded by this argument. First, "crisp taste or robust feel" is not claimed. Second, "crisp taste or robust feel" is subjective. Third, the arguments of counsel cannot take place of evidence on the record. It is the examiner's position the lack of "crisp taste or robust feel" in Hoppy must be supported by evidence.

Applicant asserts the claimed combination of components results in "unexpected" properties (Remarks, p. 11, last line; p. 12 second paragraph; p. 13, first and third paragraphs; p. 14, first paragraph; p. 18, first paragraph). As set forth in MPEP 716.02(d), whether unexpected results are the result of unexpectedly improved results or a property not taught by the prior art, "objective evidence of nonobviousness must be commensurate in scope with the claims which the evidence is offered to support". In other words, the showing of unexpected results must be reviewed to see if the results occurred over the entire claimed range, *In re Clemens*, 622 F.2d 1029, 1036, 206 USPQ 289, 296 (CCPA 1980). Applicants have not provided data to show that the unexpected results do in fact occur over the entire claimed range of alcohol content. The specification reports crispness and robust feel (Specification, p. 13, Table 1). However, the

specification indicates that ratios outside the claimed range have between normal and strong crispness, as well as between normal and sufficiently strong robustness (Specification, p. 13, Table 1). Therefore, there is no evidence on the record that the claimed range of alcohol content results in unexpected properties.

Applicant argues the Office failed to supply a motivation to combine the Tripp reference (p. 14, last paragraph; p. 15, last paragraph). Examiner is not persuaded by this argument. As the application acknowledges, Tripp discloses changes in malt proportion allow a beverage with “acceptable drinkability and taste” (Remarks, p. 14, last paragraph). Therefore, Tripp demonstrates it is within the skill in the art to alter the malt proportions and that one would be motivated to alter the proportions to achieve “acceptable drinkability and taste”.

Regarding claim 17, applicant argues claim 17 does not contain a method limitation (Remarks, p. 17, para 3). Examiner is not persuaded by this argument because the specification states *otsu-rui shochu* is “shochu produced by distilling an alcohol-containing material in a batch distiller” (Specification, p. 11, ln. 3-4). Hoppy discloses shochu. The method of making the shochu, i.e. batch distilling, does not patentably distinguish the claimed shochu over the prior art shochu. Furthermore, in the remarks filed on 7/28/2009 applicant states: “The term ‘otsu-rui shochu’ is defined as ‘shochu produced by distilling an alcohol-containing material in a batch distiller’” (Remarks from 7/28/2009, p. 10, last paragraph). It is unclear how ‘otsu-rui shochu’ was a shochu produced by batch distilling on 7/28/2009, but it is not a product obtained by batch distilling in the presently filed remarks.

***Conclusion***

13. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to WALTER MOORE whose telephone number is (571) 270-7372. The examiner can normally be reached on Monday-Thursday 9:00-4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Sample can be reached on (571) 272-1376. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/WM/  
Walter Moore, Examiner AU 1783  
3/31/2010

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